

REMARKS

Claim 1 remains herein.

1. Applicant notes and appreciates the withdrawal of the prior rejection of this application.

2. Claim 1 is now rejected under § 102(b) over (1) applicant's 2003 catalogue first published November 2002, and (2) the fact that the plant sought to be patented herein was sold in the Netherlands in 2002, and (3) further in view of the RHS Dictionary of Gardening, 1992, vol. 1, pages 612-618, describing how to asexually propagate a chrysanthemum.

In essence, the rejection is based upon applicant's catalogue published in November 2002 as allegedly "enabled" by sale in late 2002 in the Netherlands, of the plant sought to be patented in the present application. The Office Action relies upon In re LeGrice, 301 F2d 929,133 USPQ 365 (CCPA 1962); Ex parte Thomson, 24 USPQ2d 1618, 1620 (Bd. Pat. App. Inter. 1992); and In re Elsner, 381F3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004). But, the Office Action overreaches at critical points in its analysis.

In LeGrice, the CCPA held that § 161 plant patents are subject to § 102(b) in the same manner as it was and is applied to other types of claimed subject matter. Importantly, the CCPA said that § 102(b) and its predecessor statutes have been interpreted "as requiring that the description of the invention in the publication 'must be sufficient to put the public in possession of the invention.'" 301F2nd at 933; emphasis added here; citing Seymour v. Osborne 11 Wall. 516, 555, 78 U.S. 516, 555 (1870). And, the CCPA said that the disclosure of a publication, to be

a statutory bar under § 102(b), “must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” id. at 936; emphasis in original; citing Cohn v. U.S. Corset Co., 93 U.S. 366 (18\_\_). The emphasis upon the cited publication being sufficient to effectively place one of the skill in the relevant art in possession of the invention sought to be patented is repeated throughout LeGrice.

Thomson involved a regular utility patent application seeking to patent a cotton plant and seeds thereof. Two publications describing the claimed plant and seeds were admittedly, per se, not enabling, but were allegedly rendered enabling by foreign availability of the plant more than one year before Thomson’s U.S. application filing date. The board in Thomson did state “The issue is not whether...[the claimed invention]...was on public use or sale in the United States, but rather whether ...[it]...was available to a skilled artisan anywhere in the world such that he/she could obtain...and make/reproduce...[it as]...disclosed in the cited publications.” 24 USPQ2d at 1620. The Board in Thomson found it reasonable to conclude that at the time that the cited articles were published, skilled artisans “throughout the world” would have found the relevant seeds readily available and “there is no evidence of record to the contrary.” Id.

In Elsner, the Federal Circuit found § 161 plant patent applications to be different from regular utility applications claiming a non-plant subject matter, saying:

Only when possession...enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sale act as a § 102(b) bar.

Elsner, 381 F3d at 1128-29. In Elsner, the court found that because the published PBR application, combined with foreign sales of the plants, apparently placed the claimed inventions “in the possession of the public” that those publications demonstrated to have been enabled by the foreign sales “are proper § 102(b) anticipatory references that may bar patentability.” *id.* at 1129; emphasis added here. But, the Federal Circuit in Elsner remanded to the PTO for further factual findings relating to the accessibility of the foreign sales and the reproducibility of the claimed plants from the plants sold.

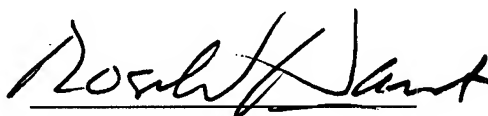
In the present application, there is no evidence in this record that sales in the Netherlands any time more than one year before the filing date of the present application, in fact resulted in, or could have resulted in, possession in the United States of plant material “to practice asexual reproduction of the plant” as claimed herein in a manner consistent with the statute. See Elsner, 381 F. 3d at 1128-29. Accordingly, the alleged bases for alleged enablement by the disclosure of applicant’s catalogue published in November 2002 are missing key facts which render the alleged bases for the present rejection incomplete, and therefore render the rejection inapposite.

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For all the foregoing reasons, reconsideration and withdrawal of this rejection, and allowance of applicant's claim 1 are respectfully requested.

This application is now believed to be fully in condition for allowance, which is respectfully requested. Should the Examiner believe that further changes to this application would put it in even better form for issue, the Examiner is invited to telephone applicant's undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roger W. Parkhurst", written over a horizontal line.

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